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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,992	03/02/2004	Sang Woon Suh	1740-000038/US.	9678

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HARNES, DICKEY & PIERCE, P.L.C.
P.O. BOX 8910
RESTON, VA 20195

EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2627

MAIL DATE	DELIVERY MODE
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07/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/789,992	Applicant(s) SUH ET AL.	
	Examiner Aristotelis M. Psitos	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-13,15-20,22-27,30-34 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-13,15-20,22-27,30-34 and 36-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) _____ | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/12/07 has been entered.

Claim Objections

1. Claims 12; 16-17,19; 20,22,23,24,25,26,30, 33; 36-40 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The following analysis is made:

With respect to claim 12:

A-1: this claim contradicts the parent claim 1, i.e., as recited in claim 1 there is no further end-user recording ability. However, claim 12 lines 3 plus differ/contradict such.

In re Hyatt, 218 USPQ 195.Response to Arguments

Applicant's arguments filed 3/12/07 have been fully considered but they are not persuasive. Again, the above objections are made.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 20,22-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, claim 20 is written as a method, –

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however, because no apparatus is recited the examiner at best interprets this claim as a single step, i.e., there must be additional recording steps, all optical recording systems provide for a recording step. This fails as is common – see *In re Hyatt*, 218 USPQ 195. ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1,5,13,15,20, 22,27,34, and 36 rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over by Sako et al – 2003/0012098 further considered with either Kondo et al ('977)/ Shim (('804).

Sako et al disclose in his description of figure 4, a wobble pit pattern – see the description of element(s) 113. The examiner interprets the information area to exist, as well as that of a lead-in and out area as well. Since this information is pre-recorded, i.e., not recorded by a user the examiner interprets the placement of such information in a control area prior to the lead in information, notably the BCA (burst cut area). If applicants' can convince the examiner that such is not the case, then under 103 considerations, the examiner further relies upon the secondary references, for teaching such.

In Kondo et al - see the description with respect to figures 21 and 22, while in Shim see the abstract for instance.

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It would have been obvious to modify the base system of Sako et al with the above teachings from the secondary references; motivation is to provide for placement of the control information/id of disc in an area not recordable by the end-user – such as the bca.

The examiner cannot ascertain any unexpected results to occur from such a placement – see for instance *In re Woodruff*, 919 F.2d 1575, 16 USPQ 2nd 1934 (Fed. Cir. 1990).

With respect to claims 5, 15, 22 and 36, these pits are interpreted as m/s with respect to a hf modulated groove. Such m/s high frequency groove is considered inherent. With respect to the wobble groove, either such is inherent – as depicted in the base reference, or well known inherent in DVD systems, i.e., wobble groove/track for appropriate dpd tracking capabilities.

With respect to claim 13, the disc is present in the base reference, hence the method of forming as recited is met.

With respect to claim 20, information is reproduced in the above system, and hence the limitation of this claim is met.

With respect to claim 27, the method limitations as recited are met.

With respect to claim 34, the apparatus limitations are met, i.e., the pick up apparatus and the controller.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

4. Claims 6-10, 16, 17, 23, 24, 30, 31, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1, 5, 13, 15, 20, 22, 27, 29, 34, 36, above, and further in view of either Timmerman et al or Ozaki et al.

Either of these secondary references depict/teach:

With respect to claims 6, 16, 23, 30 and 37, they are so aligned.

With respect to claim 7, such a limitation is disclosed in either system.

With respect to claim 8, such is present.

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With respect to claim 9, such is disclosed.

With respect to claims 10, 17,24,31 and 38, these pits are detected in the servo stage.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

5. Claims 11-12,18,19, 25,26,32,33,39 and 40 are rejected under 35 U.S.C. 103 as being obvious over the art as relied upon above with respect to claim 1 and further considered with either Kuroda et al or Muramatsu et al.

Kuroda et al discusses the rom, and write once type disc formats as well as information indicative of medium type.

Alternatively, Muramatsu et al also discloses such – see col. 1 lines 14-68.

It would have been obvious to modify the base system of either Timmermans et al or Ozaki et al with the above additional teaching from either Kuroda et al or Muramatsu et al so as to increase the media types the base references are applicable to, i.e., increase of marketed optical discs.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Receipt of the TD overcomes the previous obvious double patenting rejection. Applicants' cooperation in filing such is greatly appreciated.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-F: 6:00 - 2:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aristotelis M Psitos
Primary Examiner
Art Unit 2627

A handwritten signature in black ink, consisting of a series of loops and a long, sweeping tail that extends downwards and to the left.

AMP